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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,689	11/13/2001	Harry V. Weber	WBE-1	5262
22827	7590	12/22/2010		
DORITY & MANNING, P.A. POST OFFICE BOX 1449 GREENVILLE, SC 29602-1449			EXAMINER DASS, HARISH T	
			ART UNIT 3695	PAPER NUMBER
			MAIL DATE 12/22/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/054,689
Filing Date: November 13, 2001
Appellant(s): WEBER, HARRY V.

Richard M. Moose (Reg. No. 31,226)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/12/2010 appealing from the Office action mailed May 10, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

11-13, 15, 17, 19-25, 56-57, 59-66.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,870,721	Norris	2-1999
7,062,462	Ireland et al.	6-2006

"Financial Aid Prospecting - ONLINE: The Internet Is Loaded With Valuable Financial Aid Information, but Few Campus Web Sites Are Designed to Help Them Find It; Terrell, Kenneth. Black Issues in Higher Education. Reston: Oct 28, 1999. Vol. 16, Iss. 18; pg. 38.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

This office action is in response to Applicant's communication of 2/10/2010.

1. Declaration under 37 CFR 1.131 is accepted and entered (see previous actions).

2. ***Status of claims:***

Claims 1-10, 14, 16, 18, 26-55, 58 are canceled.

Claims 11-13, 15, 17, 19-25, 56-57, 59-66 are pending.

3. ***Rejection Withdrawn:***

Claim Rejections - 35 USC § 101

Withdrawn (see paper # 20100721)

Claim Rejections - 35 USC § 112

- second paragraph of 35 U.S.C. 112 –

Withdrawn (see paper # 20100721)

4. ***Rejection Maintained:***

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

Claims 11-13, 15, 17, 19-25, 56-57, 59-66 remain rejected under 35 U.S.C. 103(a) as being unpatentable over "Financial Aid Prospecting - ONLINE: The Internet Is Loaded With Valuable Financial Aid Information, but Few Campus Web Sites Are Designed to Help Them Find It"; Terrell, Kenneth. Black Issues in Higher Education. Reston: Oct 28, 1999. Vol. 16, Iss. 18; pg. 38 (hereinafter Terrell) in view of Ireland et al. (hereinafter Ireland – US 7,062,462) and Norris (US 5,870,721) and Applicant's Admitted Prior Art (AAPA).

Re. Claim 11, Terrell discloses applying for financial student aid **online using Internet websites** for higher education such as Sallie Mae and **linking of financial aid web page to online FAFSA to expedite the application process;**

a first information collection service for obtaining requested personal and financial information about a given student [see NPL 7 pages], Internet FTP for transferring files, a federal link service (see web page link to www.fafsa.ed.gov).

Terrell does **implicitly disclose the back-end computer processing of the financial aid application process maintained by the US Department of Education**

which interacts with applicant instantaneously to expedite the process and avoid delays which may affect the amount of aid student receives.

Terrell does not explicitly disclose

a financial aid estimation service for evaluating the information obtained via said first information collection service and generating a predicted amount of monetary aid that may be available for the student to use for education-related expenses at a given educational institution;

receiving an electronic copy of an Institutional Student Information Report (ISIR) document for the given student;

a service for comparing information obtained via said first information collection service and the given student's ISIR document;

a service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution; and

a service for providing an award notice to the given student based on the determination of authorized financial aid eligibility

However, Student loan/financial aid process, FAFSA and Institutional Student Information Report (ISIR) are well known elements and ISIR is send/received by schools electronically as well as paper copy. **Further, are known means of file transfer (receiving/transmitting) using Internet FTP and computers**, where FTP uses the address (link) of the web-server to receive/transmit files (documents, reports, etc), batch programming and telnet for automation of computer processing and viewing documents.

Ireland discloses online higher education financing system and method and online websites which provide calculating functions, and back-end computer (Network Server – see Fig. 1; col. 2 lines 32-35 (Sallie Mae which provides ...), col. 5 lines 60~). Further, **Ireland** discloses a financial aid estimation service;

generating a predicted amount of monetary aid that may be available for the student to use for education-related expenses at a given educational institution; and a service for providing an award notice to the given student based on the determination of authorized financial aid eligibility [Figures 1-3; col. 15 lines 4-26; col. 7 lines 6-31, additionally see figures which have more information].

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Terrell and include a financial aid estimation service; generating a predicted amount of monetary aid that may be available for the student to use for education-related expenses at a given educational institution; and a service for providing an award notice to the given student based on the determination of authorized financial aid eligibility, as disclosed by Ireland, to provide an online student financial aid resource which allows the student/parent to calculate the estimated cost of educational and available financial aid require for student to attend an educational institution.

AAPA discloses evaluating the information obtained via said first information collection service; a service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution [page 1-3 (background)].

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Terrell and Ireland and include evaluating the information obtained via said first information collection service; a service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution, as disclosed by AAPA, to provide a web-based student financial aid delivery and management system where the entire financial aid process is interactive and online for instantaneous Plus loan pre-approval, calculating college cost and post graduation budget planning.

Norris (analogous art) discloses a lending system, receiving applicant's information of a loan by electronic communication and automatic processing of loan, and receiving an electronic copy of loan document of borrower (**analogous** to an Institutional Student Information Report (ISIR) document for the given student); a service for comparing information obtained via said first information collection service (**database - analogous service**) and the given borrowers loan application/document (**analogous to student's ISIR document**) [See entire document particularly, abstract; Figure 1; col. 2 lines 17-34; col. 7 lines 55-65; claim 1 - comparing two documents for verification].

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Terrell, Ireland, and AAPA and include verification process, as disclosed by Norris, to provide a borrower's data matching system to verify the borrower's identity against third party database for

processing/approval of loan. ***Since the claimed invention is merely a combination of old elements, and in the combination each element merely would perform the same function as it did separately, and one of ordinary skill in the art would recognized that the results of the combination were predictable.***

Re. Claim 12, Terrell discloses wherein said web-based application further comprises a registration service for applying for and receiving a user identification element, and whereby said user identification element is utilized for obtaining future access to said web-based application, including various features and services thereof [see enrollment and online application].

Re. Claim 13, **Terrell discloses a second information** collection service, for obtaining additionally requested information related to personal demographics, financial matters, and educational endeavors of a given student [see fill up, inherent in Terrell].

Re. Claim 15, **Terrell discloses a federal link service** (www.fafsa.ed.gov) for electronically relaying federal aid eligibility information between the web based application and processing systems of selected government agencies, wherein one of said selected government agencies corresponds to the United States Department of Education.

Re. Claim 17, 19-25, and 55-59 **Terrell** discloses federal aid link service provides links at the web-based system for directly connecting a user to a FAFSA on-line web-based location and to an Ins on-line web-based location. **Ireland** discloses selected information obtained via said student file establishment service comprises information obtained via said first information collection service and said second information collection service, federal aid eligibility information obtained via said federal link service, and enrollment information about a given student obtained from an educational institution [col. 7 lines 10-30, 51-65; see database Figure 1], a file processing service for reviewing information collected about a given student via said file establishment service and for determining eligibility for various types of financial aid that are potentially available for a student, a loan application service for electronically relaying master promissory note (MPN) documentation between a system user and a loan guarantor, wherein said loan guarantor is characterized as one who provides monetary assistance to a student for education-related expenses, a reporting system service available to a user of the web-based application, for obtaining updated information about the financial aid system and progress involved with said file processing service thereof, a communications service for automatically generating and sending an electronic communication from a student or educational institution to a student financial aid processor, and wherein the user identification element received via said registration service is utilized as an electronic signature for affirming various statements presented in accordance with the multi-level financial aid system [see entire document particularly; col. 3 line 51 to col. 4 line 4; col. 6 line 55 to col. 7 line 65; col. 22 lines 7 to col. 23 line

28; claims 1-2]. Additionally, a service for obtaining a copy of an Institutional Student Information Report (ISIR) document for the given student, a service for obtaining enrollment verification information for the given student from one or more specified educational institutions, and wherein selected portions of the information obtained from said first information collection service, said service for obtaining a copy of an ISIR document and said service for obtaining enrollment verification information are reviewed by a financial aid processing center, a service for comparing information obtained via said first information collection service and the given student's ISIR document; a service for determining what financial aid the given student is eligible for; and a service for providing an award notice to the given student based on the determination of financial aid eligibility, and a service for determining whether the given student's corresponding information complies with federal regulatory standards for financial aid eligibility are inherent in Terrell, Ireland and AAPA. Further, an integrated feature that automatically updates the web-based application, particularly updating information related to received documents and progress of financial aid processing is well-known specially software companies website such as Microsoft explores which automatically updates the website. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Terrell, AAPA and Norris and include the disclosure of Ireland, as disclosed above, to provide a method and apparatus for students and parents with education financing information, online filing at reduce the costs for a school to transmit financial aid award packages to potential students and help student to apply timely for student aid and get the

result/decision quickly using their computer. Since the claimed invention is merely a combination of old elements, and in the combination each element merely would perform the same function as it did separately, and one of ordinary skill in the art would recognized that the results of the combination were predictable.

Claims 60-66 are rejected with same rational as claim 11 and associated dependent claims (Terrell in view of Ireland, AAPA and Norris).

(10) Response to Argument

In response to appellant's argument recitation (page 6 – argument), "The pending rejection citing Terrell, Ireland et al., Norris and AAPA ***fails to constitute a prima facie case of obviousness under 35 U.S.C. § 103(a)***. The combination of references fails to disclose the one or more elements set forth in independent claims 11 and 60. ***A person of ordinary skill in the art, having common sense at the time of the invention, would not have reasonably looked to the combination of references set forth in Final Office Action.*** The Examiner respectfully disagrees with following explanation(s):

1. "...***fails to constitute a prima facie case of obviousness under 35 U.S.C. § 103(a)***." During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification, as it would be interpreted by one of ordinary skill in the art. In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004). An obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, In re Hedges, In re Piaseckii, In re Rinehart, In re Fine, In re Jones, See also In re Eliillli & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990); Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Using this standard, the ***Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence*** of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for

combinations that fairly suggest Applicant's claimed invention (see Paper # 20100506). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are either accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness (see *In re Okajima v. Bourdeau* and *In re Soli*). As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300(Bd. Pat. App &.,4/293 and "to determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art".

2. "***A person of ordinary skill in the art*** ..." See *In re Okajima v. Bourdeau* for ordinary skill in the art, and also re KSR "A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton. ... will be able to fit the teachings of multiple patents together like pieces of a puzzle. ... In addition to the factors above,

Office personnel may rely on their own technical expertise to describe the knowledge and skills of a person of ordinary skill in the art.”

In response to appellant's argument recitation (page 6 – argument) “The combination of references fails to disclose the one or more elements set forth in ...” Appellant has failed identified any limitation that is(are) not addressed explicitly or implicitly. See Paper # 20100506 pages 7-10 for claim 11 (computer readable medium) and page 13 for claim 60 (computer readable medium).

In response to appellant's argument recitation (page 7 – argument) “**would not have reasonably looked to the combination of references set forth in Final Office.**” See In re Keller.

In response to appellant's argument recitation (page 7 – argument) “**Finally, secondary considerations including evidence of commercial success bolster a finding of nonobviousness of the pending claims over the cited references.**” See Paper # 20100506, the Declaration is accepted and entered, but it does not overcome the evidence provide in the prima fascia case. See MPEP 716.03(b) “In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a ... In re Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little

weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973). The secondary consideration (Declaration under 37CFR 1.132) has been considered but per Examiner's judgment based on provided evidence is not sufficient to overcome the prima facie case.

In response to appellant's argument recitation (page 8 – argument) "***The key to supporting any rejection under 35 U.S.C. s 103 is the clear articulation of the reason(s) why ...***", the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has stated clearly why one practitioner in the art of student financial aid will combine the old known elements, where each element merely would perform the same function as it did separately, and one of ordinary skill in the art would recognize that the results of the combination were predictable. For example, page 8-9 clearly states why one skill in the art will combine the primary reference Terrell with teaching of elements by secondary reference of Ireland (analogous art) "to provide an online ..." the fact Appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences

would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Similarly, the examiner has stated (page 9-10 paper # 20100506) why the old know elements of prior art are combinable with a predictable result which will be recognized by one practitioner (see *In re Okajima v. Bourdeau*) in the filed of financial aid.

In response to appellant's argument recitation (pages 8-9 – argument) "providing a multi-level financial aid system ..." (Norris an analogous are - abstract "automatic processing a loan ... application, underwriting and transferring funds."), (Paper # 20100506 page 9 "receiving an electronic copy ... " and page 8 lines 3-8"). See *In re Oetiker*. **Further**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Also, see for Preamble, *In re Hirao*, and *Kropa v. Robie*.

In response to appellant's argument recitation (page 9 – argument) "Terrell fails to disclose all limitations ..." The rejection is under USC 103(a) not USC 102. The claims 11-13, 15, 17, 19-25, 56-57, 59-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terrell in view of Ireland, Norris and Applicant's Admitted Prior Art (AAPA). Combinations of Terrell, Ireland, Norris and AAPA disclose all of the limitation

claimed in claims 11-13, 15, 17, 19-25, 56-57, 59-66. See paper # 20100506 page 7 limitations disclosed by Primary reference (Terrell) and page 7 line 11 through page 8 line 2 and disclosed limitations disclosed by secondary references (Ireland and Norris) and Official Notice (evidence pages 8-10). If Appellant disagrees with any factual findings by the Office, an effective traverse of a rejection based wholly or partially on such findings must include a reasoned statement explaining why the applicant believes the Office has erred substantively as to the factual findings. A mere statement or argument that the Office has not established a *prima facie* case of obviousness or that the Office's reliance on common knowledge is unsupported by documentary evidence will not be considered substantively adequate to rebut the rejection or an effective traverse of the rejection under 37 CFR 1.111(b). Office personnel addressing this situation may repeat the rejection made in the prior Office action and make the next Office action final. See MPEP § 706.07(a).

In response to appellant's argument recitation (page 10 – argument) "nothing about ..."
1). Filling forms which include personal information is inherent in online application of Terrell (for example, see fill out the forms, how does a student fills out forms for financial aid with out providing personal information?)

2). "Nothing about FTP ..." See MPEP § 2144.03 and MPEP § 706.07, If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence. To adequately traverse such a finding, an applicant must

specifically point out the supposed errors in the examiner's action. If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art. See the prosecution history, Appellant has failed to provide any documentary evidence that the Examiner has erred (faulted) and these limitation are new and the inventor's original thoughts or invention(s).

In response to appellant's argument recitation (page 10 – argument) “**Terrell is a brief 1400 word ...**” Terrell is a Non-Patent Literature a Prior Art, which clearly establishes an exists of student financial aid and online application (virtual application), a concept of financial aid web page and webpage address for financial aid related sites such as: www.fafsa.ed.gov, etc. See *In re Keller*.

In response to appellant's argument recitation (page 11 – argument) “**Ireland et al. fails to cure the deficiencies of Terrell ...**” See Paper # 20100506 page 8 line 9 though page 9 line 3 and In re *In re Keller*, *In re Oetiker*, *In re Fine*, *In re Jones*, and *Ex parte Obiaya*.

In response to appellant's argument recitation (page 13 – argument) “**The Background of the invention ...**” See MPEP 704.12 (F) Whether the specification's background of the invention describes information as being known or conventional, which may be

considered as an admission of prior art, but such information is unfamiliar to examiner and cannot be found within the application file or from the examiner's search, and further details of the information would be relevant to the question of patentability.

In response to appellant's argument recitation (page 14 – argument) “**Norris fails to cure the deficiencies of Terrell with respect to independent claims 1 and 60 ...**”
[Supra – see *In re Keller*, *In re Oetiker*, *In re Fine*, *In re Jones* and *In re Gorman*.]

In response to appellant's argument recitation (page 19 – argument) “**Only improper hindsight gained from exposure to Appellant's disclosure would lead the person of ordinary skill from Terrell, Ireland et al., Norris, AAPA and "common knowledge ...**” It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Harish T Dass/

Primary Examiner, Art Unit 3695

Conferees:

/Charles R. Kyle/

Supervisory Patent Examiner, Art Unit 3695

/Vincent Millin/

Appeals Practice Specialist